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JUN 22 2009

OFFICE OF PETITIONS

In re Application of	:	
Gerfast	:	
Application No. 10/733,944	:	DECISION
Filed: 12 December, 2003	:	
Attorney Docket No. (None)	:	

This is a decision on the petition, filed on 24 March, 2009, to revive under 37 C.F.R. §1.137(b) and alleging abandonment due to unintentional delay.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

Petitioners attentions always are directed to the guidance in the Commentary at MPEP §711.03(c)(II).

BACKGROUND

The record reflects that:

Applicant, failed to reply timely and properly to the non-final Office action mailed on 20 May, 2005, with reply due absent an extension of time on or before 20 August, 2005.

Thereafter:

Petitioner's 6 June, 2005, amendment was followed by the 28 March, 2006, Notice of Non-Compliant Amendment. (All documents discussed herein previously were provided.) Petitioner's 2 April, 2006, amendment was followed by the 16 June, 2006, Notice of Non-Compliant Amendment. Petitioner's 23 June, 2006, amendment was followed by the 12 June, 2007, Communication. Petitioner's 27 June, 2007, amendment was followed by the 27 June, 2007, Notification of Fee Due.

The Office mailed the Notice of Abandonment on 25 February, 2008;

On 3 March, 2008, Petitioner filed a petition under 37 C.F.R. §1.181 with, *inter alia*, an averment that replies had been timely and properly filed to non-final Office action, and reasserting an earlier complaint that the "delay was at the PTO"—and ignoring that the extension of time requirement was to make timely Petitioner's reply under the then-current Fee Schedule. The petition was dismissed on 24 March, 2008, *inter alia*, for failing to make the required showing. (Petitioner was cautioned to consult the Office website (www.uspto.gov) to ascertain the amount of fees due under the current Fee Schedule and ensure that passage of time between Notice and reply does not trigger a requirement for additional extensions if available.)

On 7 April, 2008, Petitioner filed a second petition—under 37 C.F.R. §1.137(b) averring unintentional delay, and the petition was dismissed on 19 June, 2008, for failure to pay the proper fee because Petitioner erroneously paid the fee for a petition averring unavoidable delay.

On 27 June, 2008, Petitioner filed a petition and set forth on the face of the petition that a fee of \$700.00 was being paid, however, upon review Office records did not reveal receipt of any payment by Petitioner with the petition, and as of that time the fee for the petition was \$810.00. (Petitioner again was cautioned to consult the Office website (www.uspto.gov) to ascertain the amount of fees due under the current Fee Schedule and ensure that passage of time between Notice and reply does not trigger a requirement for additional extensions if available). Thus Petitioner's showing did not conform to the showing requirements under the rule and the petition was dismissed on 24 November, 23008.

On 28 November, Petitioner filed a petition under 37 C.F.R. §1.137(b) averring unintentional delay, with fee, the reply in the form of an amendment and thereafter supplemented with the drawings on 24 February, 2009, and made the statement of unintentional delay. *However, what is clear from the 24 February, 2009, submission, as with those before it, Petitioner continued to ignore the directions in the Notice of 28 March, 2006, which again was enclosed, as to the proper marking of amended drawings and amendments to the specification and claims.* The petition was dismissed on 27 February, 2009.

On 24 March, 2009, Petitioner filed a petition under 37 C.F.R. §1.137(b) averring unintentional delay, with fee, the reply in the form of an amendment and drawings, and made the statement of unintentional delay (see statement in form submitted on 7 April, 2008).

The record (including the petitions filed on 3 March, 7 April, 27 June, and 28 November, 2008, and 24 March, 2009) does not necessitate a finding that the delay between midnight 20 August, 2005 (date of abandonment), and 24 March, 2009 (date of filing of grantable petition), was not unintentional. (*Again it is noted that the Office did not mail a Notice of Abandonment until 25 February, 2008.*)

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioner Sten R. Gerfast when accepting Petitioner's representation that the delay in filing the response was unintentional.¹

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³ The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁴))

¹ See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

³ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁴ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that the requirements herein under 37 C.F.R. §1.137(b) have been satisfied.


CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to the Technology Center/AU 2834 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁵) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).


/John J. Gillon, Jr./
John J. Gillon, Jr.
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Office of Petitions

⁵ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.